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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,478	01/11/2001	Dale C. Gledhill	03411.006	9341
22913	7590	10/15/2004	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			CHIANG, JACK	
			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/758,478

Applicant(s)

GLEDHILL, DALE C.

Examiner

Jack Chiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 20-37 is/are pending in the application.
- 4a) Of the above claim(s) 7-13 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 20-21, 23-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**RESTRICTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, 20-21, 23-37, drawn to an product, classified in class 379, subclass 449.
  - II. Claims 7-13 and 22, drawn to process of making, classified in class 364, subclass 138+.
2. Inventions Group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process.
3. During a telephone conversation with Ms. Sara D. Jones on 10-04-04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 20-21, 23-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-13 and 22 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

## **CLAIMS**

### **112 First Paragraph Rejection**

4. Claims 1-6, 20-21, 23-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1, 23, they claimed "... base portions are configured to be selectively positioned closer together or farther away from each other...", in claim 29, it claimed "a second portion comprising a space .... Increasing or decreasing the size of the space...". First, it is noted that the shoulder rest is made of flexible material in page 7 of the specification. It is also common to have shoulder rests made of flexible material in order to comfortably rest on the user's shoulder. However, there is no original disclosure about selectively positioning the base portions, or increasing or decreasing the size of the space. Second, applicant provides two different sizes of the shoulder rests (figs. 1-2) to fit different sizes of handsets, now applicant is claiming to selective position the base portions or space to fit different sizes of handsets, there is a difference between these two concepts. Third, all embodiments (figs. 1-2) have a strip (claims 3, 23, 36) across the base portions, and this strip is meant to be adhered onto the handset, when the base portions are pushed toward each other, this strip would tend to fold upon itself or at least create a non-adhesive area between the strip and the

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handset, there is no disclosure of such intended use of the shoulder rest. In conclusion, the claims are not supported by the original disclosure and considered as a new matter.

### **Art Rejection**

**(new matter has not been considered or entered)**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 6, 29-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Russo (US 4817139).

Regarding claim 1, Russo shows a shoulder rest comprising:

A first portion (32) for abutting against a user's shoulder;

Base portions (26, 38, 40, 42) extending from the first portion (32) to terminal ends, the terminal ends of the base portions (26, 38, 40, 42) configured for abutting (see 28) against a back side of a handset (24);

A cut-out portion (between 40, 42) between the base portions for allowing the shoulder rest to conform to different shaped handsets.

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Regarding claim 29, Russo shows a shoulder rest comprising:

A first portion comprising means (32) for abutting against a user's shoulder;

A second portion comprising a space (between 40, 42), the second portion comprising means (40, 42) having the space so that the shoulder rest can conform to differently shaped handsets;

Means (see 28) for connecting the second portion to a handset.

Regarding claims 2, 6, 30-35, Russo shows:

The curved first portion (32);

The first and base portions or means (fig. 3) of the shoulder rest are part of a hollow body or space (between 40, 42) of the shoulder rest;

These base portions are usually made of plastic material which is flexible; and

The adhesive material (see 28).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in view of Castle et al. (US 6341163).

Regarding claims 3-5, Russo shows a shoulder rest (see comments above).

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Russo differs from the claimed invention in that it does not show a strap and the claimed shape of the first portion.

However, Castle teaches providing a strap (i.e. 224, 110, 102) between the base portions. Castle further shows the first portion (see 400) narrows along a length from a front end to a narrowest portion and then widens again.

Hence, it would have been obvious for one skilled in the art to modify Russo with a strap and adhesive or Velcro as taught by Castle, such that to reinforce the engagement between the handset and the shoulder rest. Further, the shape of the first portion is a variation of Russo as long as the shoulder rest can be comfortably rested on the user's shoulder.

9. Claims 1-2, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutton (US 4961223) in view of Sutton (US 4759058).

Regarding claim 1, Sutton'223 shows a shoulder rest comprising:

A first portion (10) for abutting against a user's shoulder;

Base portions (17, 18) for abutting against a back side (21 in figs. 2 and 4) of a handset (H);

A cut-out portion (between 17-18) between the base portions for allowing the shoulder rest to conform to different shaped handsets.

Sutton'223 differs from the claimed invention in that it does not explicitly mention to use an adhesive when mounting the handset.

However, Sutton'058 teaches providing a base portions (54) for abutting and adhering (see 57) against a back side of a handset (5).

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Hence, the concept of mounting the shoulder rest with the handset is well taught by both Sutton, it would have been obvious for one skilled in the art to modify Sutton'223 with an adhesive as taught by Sutton'058, this simply can be considered as an reinforcement of the Sutton'223 as it is taught from the family of patents shown by Sutton.

Regarding claims 2, 6, Sutton shows:

The curved first portion (10);

The first and base portions (fig. 1) of the shoulder rest are part of a hollow body (between 17-18) of the shoulder rest.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-5, are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sutton'223 and Sutton'058 in view of Castle et al. (US 6341163).

Regarding claims 3-5, the combination of Sutton shows a shoulder rest (see comments above).

Sutton differs from the claimed invention in that it does not show a strap and the claimed shape of the first portion.



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However, Castle teaches providing a strap (i.e. 224, 110, 102) between the base portions. Castle further shows the first portion (see 400) narrows along a length from a front end to a narrowest portion and then widens again.

Hence, it would have been obvious for one skilled in the art to modify Sutton with a strap and adhesive or Velcro as taught by Castle, such that to reinforce the engagement between the handset and the shoulder rest. Further, the shape of the first portion is a variation of Sutton as long as the shoulder rest can be comfortably rested on the user's shoulder.

### **Art Rejection**

**(new matter has been considered or entered)**

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-6, 21, 23, 25-33, 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Castle et al. (US 6347163).

Regarding claim 1, Castle shows a shoulder rest comprising:

A first portion (400, 208, 204 in fig. 13d) for abutting against a user's shoulder;

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Base portions (196, 198; or 26, 28) extending from the first portion (400, 208, 204) to terminal ends, the terminal ends of the base portions (196, 198; or 26, 28) configured for abutting against a back side of a handset (see fig. 13d);

A cut-out portion (between 196-198; between 26, 28) between the base portions for allowing the shoulder rest to conform to different shaped handsets;

At least a portion of the base portions (196 or 198; 26, 28) are configured to be selectively positioned closer together or farther away from each other so that the shoulder rest can conform to differently shaped handsets (see fig. 13d).

Regarding claim 23, Castle shows a shoulder rest comprising:

A top portion (400, 208, 204 in fig. 13d) for abutting against a user's shoulder;

A bottom portions (196, 198; or 26, 28) extending from the top portion (400, 208, 204), the bottom portion comprising first and second base portions (196, 198; or 26, 28) extending from the top portion, at least a portion of the base portions (196 or 198; 26, 28) are configured to be selectively positioned closer together or farther away from each other;

A flexible strap (i.e. 22) between the base portions (i.e. 26, 28).

Regarding claim 29, Castle shows a shoulder rest comprising:

A first portion comprising means (400, 208, 204 in fig. 13d) for abutting against a user's shoulder;

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A second portion comprising a space (between 196, 198; or 26, 28), the second portion comprising means (196, 198; or 26, 28) for increasing or decreasing the size of the space so that the shoulder rest can conform to differently shaped handsets;

Means (loop formed by 196, 198; or 26, 28) for connecting the second portion to a handset.

Regarding claims 2-6, 21, 25-28, 30-33, 35-36, Castle shows:

The curved first portion (see 400);

The first and base portions (400; 196, 198 or 26, 28) of the shoulder rest are part of a hollow body (between 196-198; or 26, 28) of the shoulder rest, and are flexible;

A strap (i.e. 22) between the base portions (i.e. 26, 28), Castle further shows the first portion (see 400) narrows along a length from a front end to a narrowest portion and then widens again

The first and second base portions or means (196, 198; or 26, 28) for increasing or decreasing the size of the space between the first and second base portions (196, 198; or 26, 28).

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 20, 24, 34, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castel et al. in view of Russo.

Regarding claim 20, 24, 34, 37, Castel shows the mounting of the shoulder rest onto the handset.

Castel differs from the claimed invention in that it does not show an adhesive for such mounting.

However, Russo teaches providing an adhesive (i.e. see 28) for mounting a shoulder rest onto a handset.

Hence, the concept of mounting the shoulder rest onto the handset is well taught by both Castel and Russo, it would have been obvious for one of ordinary skill in the art to modify Castel's mounting with an adhesive as taught by Russo, such that to re-enforce the mounting of the shoulder rest as taught by Russo's use of adhesive.

### **ARGUMENT**

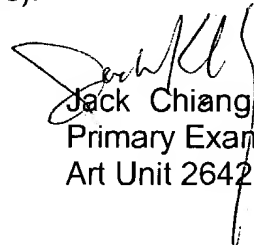
16. In response to the remarks filed on 06-23-04, pages 11-18, applicant mainly argues about the features of selectively positioning the base portions closer together or farther away from each other. This issue has been addressed in various rejections above, see comments above.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jack Chiang  
Primary Examiner  
Art Unit 2642

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